



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,370	09/22/2003	Jeff Lippy	361752002200	5011

7590 06/12/2006

Wayne C. Jaeschke, Jr.
Morrison & Foerster LLP
Suite 300
1650 Tysons Boulevard
McLean, VA 22102

EXAMINER

KUHNS, ALLAN R

ART UNIT	PAPER NUMBER
----------	--------------

1732

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,370

Applicant(s)

LIPPY ET AL.

Examiner

Allan Kuhns

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 1732

1.Applicant's election without traverse of Group I in the reply filed on March 21, 2006 is acknowledged.

2.The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.Claim 15 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Akao et al. (5,492,741). Akao et al. disclose the basic claimed sheet or gasket structure including a crosslinked web or sheet having a thickness of from about 0.2 to about 3 mm and a degree of crosslinking of less than 75%. Note column 54, lines 56-67 and column 3, lines 57-67. Alternatively, it would have been obvious to one of ordinary skill in the art to practice the designated mixing, extruding, cooling, crosslinking and heating steps in order to produce a sheet or web of material having the properties disclosed by Akao et al. Note MPEP 2113 with regard to the treatment of product-by-process claims. The aspect that the web or sheet is to be used as an isolation gasket is essentially a statement of its intended use rather than a limitation on the structure of the sheet.

5. Claims 1 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao et al. (5,492,741). Akao et al. disclose or suggest the basic claimed material including a crosslinked polyolefin foam having a density of from about 60-200 kg/m³ and a thickness of at least 0.5 mm. Note column 54, lines 56-67. Based on the disclosed density and thickness ranges for the crosslinked material of Akao et al., it is submitted that this material inherently possesses compressive and shear strength properties within the claimed ranges of claims 1, 8 and 9. Given the cushioning and light shielding properties of the material, and the physical strength disclosed by Akao et al. at column 5, lines 46-50, it would have been obvious to one of ordinary skill in the art to expect that the sheet of Akao et al. to be capable of acting as an isolation material.

Akao et al. teach a sheet with a thickness and density within the ranges of claims 5 and 7 at column 54, lines 54-67 and suggest a fine cell structured foam, as in claim 6, based on the nucleating agents employed.

6. Claims 2-4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao et al. as applied to claims 1 and 5-9 above, and further in view of White (5,955,163). White discloses a crosslinked polyolefin foam comprising an ethylene propylene copolymer and low density polyethylene as an effective composition to form a gasket. It would have been obvious to one of ordinary skill in the art to modify the polyolefin structure of Akao et al. by adding an ethylene propylene copolymer in order to form an effective gasket material. Note column 8, line 60 to column 9, line 4 of White, which also teaches or suggests addition of ethylene propylene copolymer within

Art Unit: 1732

the ranges of claims 3 and 4. Akao et al. suggest a degree of crosslinking in the manner of claims 10 and 11.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (571) 272-1202. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Allan R. Kuhns

ALLAN R. KUHN
PRIMARY EXAMINER AU 1732

6 - 7 - 06